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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,179	08/07/2003	Ulrich Birnbaum	DT-6591	3742
30377	7590	10/25/2006		
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			EXAMINER MACARTHUR, VICTOR L	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/638,179

Applicant(s)

BIRNBAUM ET AL.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 16-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-13, 15 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/2006 has been entered.

### ***Election/Restrictions***

Claims 9, 16-18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/14/2005.

### ***Preamble***

The preamble of claim 1 merely recites the use or purpose of the claimed invention such that the body of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Accordingly, the examiner has determined that the preamble does not limit the claim. The examiner has considered the claims **without** combination. See MPEP 2111.02 and *Kropa v. Robie*, 88 USPQ at 480-481; *Rowe*, 42 USPQ2d at 1553; and *IMS Technology Inc. v. Haas Automation Inc.*, 54 USPQ2d 1129, 1137 (Fed.Cir.2000). Claims 5, 6 and 15 are primarily drawn to a support recited in claim 1 as only being intended to be used with the connecting element. Accordingly these claims are taken as

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merely elaborating on an intended use. If the applicant intends for the invention to be positively limited by a “support” then claim 1 should be amended accordingly, e.g., by positively claiming --A connecting element of an assembly system comprising a plurality of system supports--. The preamble of claim 22 is similarly taken **without** combination.

### ***Claim Objections***

Claims 1 and 4 are objected to because of the following informalities:

- The limitation “of said parallel sides of said parallel sides of said at least one elongated opening with elongated parallel side” (lines 8-10 of claim 1) should be replaced with --of said parallel sides of said elongated opening,-- to improve claim clarity.
- The limitation “at least one said elongated opening” (lines 2-3 of claim 4) should be replaced with --said at least one elongated opening-- to improve claim clarity.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-13, 15, 19, 20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Seibold (U.S. Patent 5,435,107).

Claim 1. Seibold discloses (figs.2 and 4) a connecting element, the connecting element comprising a first member (3) and at least one second member (1) with at least one of said first and second members having at least one elongated opening (10) with elongated parallel sides (elongated sides of 10) and with at least a plurality of notches (18) extending continuously in side-by-side relation over the length of said parallel sides of said at least one elongated opening, said notches extending transversely of the length of said elongated opening. Note that the Seibold connecting element is structurally capable of performing the intended use of being “for an assembly system comprising a plurality of system supports having openings arranged in a defined spacing on at least one of a plurality of outer wall of the support”. Further note that the Seibold elongated opening is structurally capable of performing the intended use limitation of being “for securing said connecting element to a system support or to a base surface by a fastening element, passed through the at least one elongated opening, and engageable with complementary notches of the fastening element”.

Claim 2. Seibold discloses that the second member is arranged essentially perpendicular to said first member.

Claim 3. Seibold discloses that said second member is a connector formed of a profile section (profile section of 1) with openings (openings in 1) for fixing a support by said fastening elements passable through said openings in said connector.

Claim 4. Seibold discloses that the connector comprises a base plate (base plate of 3) and said base plate has at least one said elongated opening (10) with said notches (10) located along

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the length of the at least one elongated opening for engagement with complementary notches of one said fastening element (as previously recited in claim 1, see claim objections above).

Claims 5, 6 and 15. Seibold discloses that the connector has an outer contour and an inner contour such that the Seibold connecting element is structurally capable of performing the intended use of being for an assembly system comprising a plurality of system supports of complementary contour so that said supports can slide over said connector and/or inserted into the connector.

Claim 7. Seibold discloses that said connector has a rectangular configuration and the openings are arranged parallel to a plane (plane parallel to openings and through said first member) for the passage of a fastening element, with said plane formed through said first member of the connecting element.

Claim 8. Seibold discloses that a plurality of additional openings (additional openings in 1 receiving 22) are arranged vertically relative to each other in a plurality of planes parallel to each other.

Claim 10. Seibold discloses that said notches comprise teeth.

Claim 11. Seibold discloses that the connecting element has at least one bead (bead in 3 having the teeth) extending in the elongated direction of said openings.

Claim 12. Seibold discloses that the teeth are arranged in at least one bead wall of said at least one bead.

Claim 13. Seibold discloses that a surface zone (surface zone having the notches) surrounding at least one said elongated opening has said notches.

Claim 19. Seibold discloses that the second member is formed of a hollow section.

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Claim 20. Seibold discloses that the base plate is arranged in the same plane as the first member.

Claim 22. Seibold discloses (figs.2 and 4) a connecting element, the connecting element comprising a first member (3) and at least one second member (1) with at least one of said first and second members having at least one elongated opening (10) with elongated parallel sides (elongated sides of 10) and with at least a plurality of notches (18) extending transversely of the length of said elongated opening; said connecting element has at least one bead (top bead of 3) formed therein and including said at least one elongated opening with said bead having bead walls (walls in bead on either side of 10) extending in the direction of said elongated opening and said notches comprise teeth (18) arranged in said bead walls. Note that the Seibold connecting element is structurally capable of performing the intended use of being “for an assembly system comprising a plurality of system supports having openings arranged in a defined spacing on at least one of a plurality of outer wall of the support”. Further note that the Seibold elongated opening is structurally capable of performing the intended use limitation of being “for securing said connecting element to a system support or to a base surface by a fastening element, passed through the at least one elongated opening, and engageable with complementary notches of the fastening element”.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seibold (U.S. Patent 5,435,107).

Claim 21. A pitch of 2.5 mm is within the scope of the disclosure of the Seibold teeth. However, Seibold does not expressly state the exact tooth pitch. Seibold states that the teeth are for prevention of sliding between components (col.3, ll.52-57). One of ordinary skill in the art would recognize that a tooth pitch of 2.5 mm is capable of preventing sliding between components. It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to optimize the proportion of the Seibold tooth pitch to be 2.5 mm, in accordance with the scope of the Seibold disclosure, as such practice is a design consideration within the skill of the art.

### ***Response to Arguments***

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that elements 15, 16, 12 and 20 of Seibold do not read on the applicant's limitations. This is not persuasive since these elements have not been relied upon to reject the applicant's claims.

The applicant argues that Seibold does not disclose notches. This is not persuasive since Seibold clearly discloses notches (18) as are detailed in the prior art rejections above.

The applicant argues that Seibold does not disclose complementary notches. This is not persuasive since the applicant does not positively claim “complementary notches”. Rather, the applicant merely claims that the notches are “engageable with complementary notches” during the intended use of being “for” securing said connecting element to a system support. If the applicant truly intends for the claims to be positively limited by “complementary notches” and a “system support” then the claims must be amended to positively recite such structure (i.e., by deleting the intended use terminology “for” from lines 1 and 11 of claim 1). See Preamble section at the beginning of this Office Action for further explanation.

The applicant argues that Seibold does not provide a structure “for an assembly system”. This is not persuasive. The examiner has gone to great lengths (see Preamble section above and prior art rejections of claims 1 and 22) to inform the applicant that the limitation “for an assembly system” is an intended use limitation. Since the applicant’s claims are directed to an invention of product, rather than a method of using, the applicant’s recited intended use does not overcome prior art that suggests all of the applicant’s positively claimed structure and is capable of performing the applicant’s intended use in at least a broad sense. The applicant has failed to persuasively detail how any of the prior art would be structurally incapable of performing any of the applicant’s intended use limitations.

The applicant argues that Seibold does not disclose a “bead”. This is not persuasive. As detailed in the rejections above, the top portion of element 3 of Seibold is a bead within the broadest interpretation of the claim language.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



VLM  
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